UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,328	09/10/2003	Paul Spaeth	16222U-011310US	5961

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EXAMINER
RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/660,328	SPAETH ET AL.
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>15 September 2009</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,4-7,9-20,35-43,45,46,48-51,53 and 55-63</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,4-7,9-20,35-43,45,46,48-51,53 and 55-63</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to Request for Continued Examination filed September

15, 2009. Applicant amended claims 1, 43, 46, 48-51, 53, 55, canceled claims 2-3, 44, 47 and

added claims 59-63. Claims 1, 4-7, 9-20, 35-43, 45, 46, 48-51, 53, 55-63 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

Claims 35-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. Claim 35 recites the acceptance point device comprising *means for receiving a*

request directly from the loyalty program participant for changing the participation status in the

loyalty program from a first status to a second status. The specification however does not

disclose a means for receiving a request by the participant at the acceptance point device.

Claim 39 also recites a networked computer device configured to communicate with the

portable device, the computer device comprising of means for receiving a request directly from

the loyalty program participant for changing the status. However the specification does not teach

a means for the participant to request the change.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

Claims 1-7, 9-20, 35-42, 46, 48, 50, 51, 53, 55-58 are rejected under 35 U.S.C. 112,

second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. Claim 1 recites receiving, by an

acceptance point device, an indication from the loyalty program participants to change the

participation status in the loyalty program from a first status to a second status. According the

specification the "acceptance point device" can be a POS, cellular phone, PDA, reader, set-top-

box, etc,. It is unclear what applicant means by *receiving* by the device *an indication from the*

participant. The scope of the claimed invention could not be determined since there is no clear

step performed by the participant at the acceptance point device. Is there any input by the

participant at the acceptance point device? Clarification is required.

Claims 13 and 46 are recite similar limitation and are rejected for the same reason stated

above.

Claim 35 recites the acceptance point device comprising *means for receiving a request*

directly from the loyalty program participant for changing the participation status in the loyalty

program from a first status to a second status. It is unclear what means is used to receive a

request directly from the participant since the specification does not disclose user performing any

step, at the acceptance point device, for changing the status.

Claim 39 is rejected for the same reason stated in claim 35.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

Claims 1, 4-7, 9-20, 35-43, 45, 46, 48-51, 55, 56 and 59-63 are rejected under 35

U.S.C. 102(e) as being anticipated by DiRaimondo et al. (US 7,032,047).

Regarding claims 1, 39-42 and 56, DiRaimondo teaches *after a portable device has been*

activated receiving *by an acceptance point device* an indication to change the participation status

in the loyalty program from a first status to a second status; receiving card image data from the

portable device the card image data including a parameter having a value; modifying the

parameter in the card image data; sending the card image data to the portable device (see col. 5

line 10 to col. 6 line 45). DiRaimondo teaches (see fig. 4, 5) the customer reports to the customer

service center that the card is lost, stolen or found (the card to be disable or enabled, i.e., a

change of status); when the card is presented at the card acceptance location (acceptance point

device) the parameter of the card is modified. Therefore, DiRaimondo teaches that the indication

to change the status of the card is initiated by the participant.

Regarding claims 4-7 and 10-12, DiRaimondo teaches sending an indication that the parameter in the portable device was modified from the first value to the second value to a host; further comprising changing a record for the status of the portable device to the second status at the host; wherein if the first status is an active status, the second status is an inactive status, and wherein if the first status is an inactive status, the second status is an active status; wherein the indication to change the participation status is received at an acceptance point device; and wherein the acceptance point device is configured to communicate with the portable device; wherein the indication to change the participation status is provided by the loyalty program participant or a host managing the loyalty program (see fig. 6A, 6B, col. 10 line 30 to col. 11 line 45); teaches wherein the participation status includes one of a plurality of levels, which includes an account level, a card level, a program level and a transaction level (see col. 4 lines 6-56).

Regarding claim 9, DiRaimondo teaches therein the indication to change the participation status is received at a computing device connected to the Internet (col. 2 lines 24-44, col. 9 lines 44-55).

Regarding claims 13-20, DiRaimondo teaches receiving a request for changing the participation status from a first status to a second status; receiving card image data from the portable device, the card image data including a parameter indicating the participation status as having the first status; modifying the parameter in the card image data, the modification of the parameter corresponding to a change of the participation status from the first status to the second status; and updating the card image data in the portable device with the modified parameter, the modified parameter indicating the participation status as having the second status; comprising establishing a connection with the portable device to allow the card image data to be received;

sending an indication to a host indicating that the parameter in the portable device was modified;

changing a record for the status of the portable device to the second status at the host (see fig.

6A, 6B, col. 10 line 30 to col. 11 line 45); teaches wherein the participation status includes one

of a plurality of levels, which includes an account level, a card level, a program level and a

transaction level (see col. 4 lines 6-56).

Regarding claims 35-38, DiRaimondo teaches *means for* receiving a request for changing the

participation status from a first status to a second status; *means for* receiving card image data

from the portable device, the card image data including a parameter indicating the participation

status as having the first status for the portable device; *means for* modifying the parameter in the

card image; *means for* updating the card image data in the portable device; *means for*

establishing a connection with the portable device to allow the card image data to be received

(see fig. 6A, 6B, col. 10 line 30 to col. 11 line 45) *means for* sending an indication to a host

indicating that the parameter in the portable device was modified (see col. 4 lines 42-59).

Regarding claim 39, DiRaimondo teaches a network computing device configured to

communicate with the portable device the networked device comprising (card reader interface);

means for establishing a connection with the portable device; *means for* receiving a request from

the loyalty program participant for changing the participation status from a first status to a

second status; *means for* receiving card image data from the portable device, the card image data

including a parameter indicating the participation status as having the first status (see fig. 6A,

6B, col. 10 line 30 to col. 11 line 45); a loyalty server module component configured to

communicate with the networked computing device and receive the sent card image data,

wherein the loyalty server module comprises : *means for* modifying the parameter in the card

image data, the modification of the parameter corresponding to a change of the participation

status from the first status to the second status; and *means for* sending the modified card image

data to the networked computing device, wherein the networked computing device further

comprises *means for* updating the card image data in the portable device with the modified card

image data, the modified parameter indicating the participation status as having the second status

(col. 10 line 33 to col. 11 line 33).

Regarding claims 40-42, DiRaimondo teaches *means for* communicating through a network

to establish a connection with the loyalty server module (see fig. 6A, 6B, col. 10 line 30 to col.

11 line 45); *means for* receiving a transaction ID from the loyalty server module; *means for* using

the transaction ID to connect to the loyalty server module through the network (see col. 5 lines

34-67, col. 9 line 20 to col. 10 line 31); teaches wherein the participation status includes one of a

plurality of levels, which includes an account level, a card level, a program level and a

transaction level (see col. 4 lines 6-56).

Regarding claims 43 and 45, DiRaimondo teaches providing a parameter in the portable

device, the parameter indicating the status of the portable device for the loyalty program;

providing card image data, the card image data including the parameter and providing a

modifying mechanism to modify the parameter in the portable device in response to a request by

a loyalty plan participant (see fig. 6A, 6B, card reported lost stolen or found by the cardholder),

the modification of the parameter corresponding to a change of the participation status in the

loyalty program from a first status to a second status for the portable device; wherein

modification occurs at the acceptance point device; wherein the portable device comprises at

least one of a smartcard, a cellular phone, a personal digital assistant (PDA), a pager, a payment

card, a security card, an access card, smart media and a transponder (see fig. 2A-2C, col. 6 line 55 to col. 7 line 17).

Regarding claims 46, 48-51 and 55, DiRaimondo teaches a portable device configured to include card image data, the card image data including information relating to the loyalty program participant and a parameter that corresponds to a participation status, the participation status having a first status or a second status and representing whether participation in the loyalty program is active or inactive; and a computing device configured to: receive an indication from the loyalty program participant to change the participation status from the first status to the second status, modify the card image data including the parameter, and update the portable device with the modified card image data; wherein the computing device is further configured to modify the card image data by retrieving the card image data from the portable device and modifying the retrieved card image data; and wherein the computing device is further configured to update the portable device by uploading the modified card image data to the portable device and replacing the card image data on the portable device with the modified card data image; wherein the computing device comprises at least one of an acceptance point device, a personal computer (PC), a workstation, a personal digital assistant (PDA), a cellular phone, a set-top box, a kiosk, and a tablet PC; wherein the acceptance point device includes a point-of-sale device; wherein the portable device comprises at least one of a smartcard, a cellular phone, a personal digital assistant (PDA), a payment card, a pager, a security card, an access card, smart media and a transponder; wherein the computing device is further configured to send an indication to a host indicating that the parameter in the portable device has been modified; wherein the indication to change the participation status from the first status to the second status is received from the

loyalty program participant; wherein the indication to change the participation status from the first status to the second status is received from a host managing the loyalty program; wherein if the first status is an active status, then the second status is an inactive status, and if the first status is an inactive status, then the second status is an active status (see fig. 1-2C, col. 6 line 55 to col. 7 line 17, col. 11 lines 4-45).

Regarding claims 59-63, DiRaimondo teaches means for sending card image data from the portable device, the card image data including a parameter indicating the participation status as having a first status, wherein the parameter in the card image data is subsequently modified, the modification of the parameter corresponding to a change of the participation status from the first status to a second status; and means for receiving the card image data with the modified parameter, the modified parameter indicating the participation status as having the second status (see col. 5 lines 34-67, col. 9 line 20 to col. 10 line 31));; wherein the portable device comprises at least one of a smartcard, a cellular phone, a personal digital assistant (PDA), a payment card, a pager, a security card, an access card, smart media and a transponder; wherein the card image data is sent to a computing device connected to the Internet (see fig. 6A, 6B, col. 10 line 30 to col. 11 line 45); and wherein the computing device is configured to communicate with the portable device; wherein the computing device comprises means for modifying the parameter in the card image data; wherein the computing device comprises at least one of an acceptance point device, a personal computer (PC), a workstation, a personal digital assistant (PDA), a cellular phone, a set-top box, a kiosk, and a tablet PC (see fig. 1-2C, col. 6 line 55 to col. 7 line 17, col. 11 lines 4-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over DiRaimondo as

applied to claim 41 above, and further in view of McDonald et al. (US 6,736,317).

Regarding claim 53, DiRaimondo teaches receiving indication to change the status by

customer (see col. 4 lines 33-41), however failed to explicitly teach a graphical user interface

used to provide the indication. McDonald teach graphical user interface used provide indication

of change to participation status (fig. 4 and col. 8 lines 1-12). Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to include the graphical

user interface of McDonald in DiRaimondo's method of regulating smart card usage and/or

concession in order to allow the user to contact the system via any available means, as in

McDonald.

Regarding claims 57 and 58, DiRaimondo is silent to returning an error message to the

portable device if the first status is the same as the second status. Official notice is taken that is

old and well known in the art of programming to provide an error message. It would have been

obvious to one of ordinary skill in the art at the time of the invention to include an error message

if the existing status of the card is the same as the requested status change, in order to inform the

card holder of the current status of the card.

Response to Arguments

Applicant's arguments filed March 9, 2009 have been fully considered but they are not persuasive. Applicant argues that DiRaimondo does not disclose "allowing a loyalty program participant to change his or her status in a loyalty program for a portable device. Applicant further states that the only control a consumer has over the smart card in DiRaimondo is to report a physical status change to customer support such as to report that a card is lost or stolen. Applicant argues that simply allowing a consumer to report a card lost or stolen is not the same thing as allowing a loyalty program participant to directly change his or her status in a loyalty program. It is unclear what step is performed by the participant for the participant to directly change the status. As claimed it is clear that the status of the parameter is changed by the acceptance point device but what the participant does for the device to change the status is not clear.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

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Primary Examiner, Art Unit 3622